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Serial No. 09/523,079

13DV-13466

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of :
Brain L. Gerhardt : Group Art Unit: 2167
Serial No. 09/523,079 : Examiner: G. O'Connor
Filed: March 10, 2000 : Response to Paper No. 6
For VIRTUAL WAREHOUSE PARTS DISTRIBUTION SYSTEM AND
PROCESS

REQUEST FOR RECONSIDERATION

Assistant Commissioner for Patents,
Washington, DC 20231

S I R:

REMARKS

This application has been carefully reviewed in light of the Final Office Action dated August 26, 2002. Claims 1-3, 6-9, and 12 remain pending in the application. Applicant hereby requests further examination and reconsideration in view of the following remarks.

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Date: <u>SEPTEMBER 9, 2002</u>	Signature: <u>Jonathan M. Hines</u> Name: <u>JONATHAN HINES</u>

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Claims 1-3 and 6 have been rejected under 35 U.S.C. 102(a) as being clearly anticipated by U.S. Patent 5,895,454 (Harrington). This rejection is respectfully traversed.

Independent claim 1 recites, among other elements, that the parts in the claimed database are sorted into a plurality of inventory categories, wherein the parts in at least one of the inventory categories are further sorted into a plurality of sub-inventory categories based upon part condition.

Harrington is directed to an integrated interface for vendor/product oriented Internet websites and discloses a networked computer system comprising an Internet-accessible database 10 which contains information on vendor products and services. A user may search the information in the database 10 and make a selection of a product, which causes the user to be directed to a vendor website 12. When the user elects to make a purchase, a transaction notification 33 is sent to the database administration software 21. At the conclusion of a shopping session, the database interface 24 transmits purchase/ordering data to the remote vendor site 12.

Harrington discloses that products may be sorted into categories. However, even if the term "products" could be considered to include parts, Harrington only discloses very general types of product categories applicable to retail items, which are presumably in new condition, for example "electronic goods" or "toys" (see column 5, lines 35-40). In contrast, the present invention stores information about part condition which provides increased usefulness to purchasers of engine parts.

Harrington clearly does not disclose a database, wherein the parts in the database are sorted into a plurality of inventory categories, and wherein the parts in at least one of the inventory categories are further sorted into a plurality of sub-inventory categories based upon part condition, as recited by independent claim 1. The Examiner has noted, in the detailed portion of the section 103 rejection of

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claims 7-9 and 12, that "Harrington does not specifically disclose the step of further sorting the parts in at least one inventory category into a plurality of sub-inventory categories, based upon part condition."

In view of the fact that Harrington does not specifically disclose the above-noted method step, and consequently does not disclose a database which sorts parts into categories, wherein the parts in at least one of the inventory categories are further sorted into a plurality of sub-inventory categories based upon part condition, the Examiner has interpreted this claim limitation to be merely a statement of intended use, stating that "a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention as the prior art in order to patentably distinguish the claimed invention from the prior art." While this statement is well taken as a general proposition, Applicant urges that it is inapplicable in the present case and that the limitation does patentably distinguish the claimed invention from the prior art. Claim 1 clearly recites, among other elements, the element of a database having a specific hierarchical arrangement of components, i.e. the recited categories and sub-categories.

Applicant respectfully points out that the reason for requiring a "structural" limitation as described in the MPEP and the quoted cases is for the purpose of distinguishing two structures capable of performing the same function. Applicant submits that, contrary to the facts in these cases, the database of Harrington is clearly not capable of performing the same function as the claimed database, precisely because it lacks the recited sub-category structure.

Furthermore, it is submitted that there is a structural difference in a database having a plurality of products divided into categories, as disclosed by Harrington, and a database wherein the parts in the database are sorted into a plurality of inventory categories, and wherein the parts in at least one of the inventory

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categories are further sorted into a plurality of sub-inventory categories based upon part condition, as recited in independent claim 1. An example of a single database category according to the present invention is shown in Figure 2 and described in specification at page 6, lines 5-20,. The illustrated exemplary sub-categories "new", "repaired", "serviceable", and "needs repair" are based on part condition. There is clearly a difference between the structures of the claimed database and the database disclosed in Harrington, which lacks the sub-categories described above. Applicant concedes that the claimed database and the database of Harrington may both be implemented through software programming. However, even assuming that the two databases were to be implemented on identical computer hardware "structures", the claimed system involves software or programming aspects (i.e. the stored database) as well as hardware. Applicant submits that a different hardware structure is not required to patentably distinguish the claims from the prior art.

In view of the above, it is submitted that Harrington fails to disclose every element of independent claim 1 and the rejection should be withdrawn.

Claims 2, 3, and 6 depend from independent claim 1 and are thus believed to be allowable for the reasons set forth above.

Claims 7-9 and 12 have been rejected as being unpatentable over U.S. Patent 5,895,454 (Harrington). This rejection is respectfully traversed.

The Examiner has stated that sorting an inventory of a particular type of part for sale into a plurality of sub-inventory categories, based upon part condition, such as "new" and "used", or "excellent", "good", and "fair", is a well known, hence, obvious method step to follow in listing part for sale. Applicant respectfully traverses the assertion that this sorting is well known and requests that the Examiner cite a reference in support of this position as required by MPEP §2144.03. Moreover, even if sorting parts into categories according to condition is

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generally well known in the art, there is nothing in the cited prior art to suggest using them in the context of the present claims. Only Applicant teaches sorting parts in a database into a plurality of inventory categories, wherein the parts in at least one of the inventory categories are further sorted into a plurality of sub-inventory categories based upon part condition. Harrington only teaches a database including products, presumably new products as there is no suggestion that Harrington contemplates otherwise. Accordingly, even if it were generally considered obvious to sort parts into categories according to condition as suggested by the Examiner, there would be no reason for one skilled in the art to further divide the product categories (e.g., "electronics", "toys", etc.) of Harrington into further sub-categories based on part (or product) condition, in the absence of Applicant's teachings. Accordingly it is submitted that it is impermissible hindsight to reject the claims on that basis.

In view of the above it is submitted that Harrington as modified clearly fails to teach all of the elements of independent claim 7 and the rejection should be withdrawn.

Claims 8, 9, and 12 depend from independent claim 7 and are thus believed to be allowable for the reasons set forth above.

In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration of the objections and rejections is requested. Allowance of claims 1-3, 6-9, and 12 at an early date is solicited.

Respectfully submitted,

September 9, 2002
Date

Jonathan M. Hines
Jonathan M. Hines, Reg. No. 44,764
Tel: 207-791-1236 / Fax: 207-791-1350

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